

REMARKS

Claims 1-7 are pending.

In the Office action, the claims were rejected as follows:

- Claims 1 and 3-7 were rejected under 35 U.S.C. 103 as unpatentable over Applicant's admitted prior art in view of U.S. Patent Publication No. 2001/0036218 (Funakawa).
- Claim 2 was rejected under 35 U.S.C. 103 as unpatentable over Applicant's admitted prior art in view of the Funakawa publication and further in view of U.S. Patent No. 6,295,306 (Asami).

As discussed below, applicant respectfully disagrees. In particular, contrary to the statement in the Office action, the Japanese filing date of the Funakawa publication is *not* the relevant date for determining its status as prior art.

The Funakawa publication is not properly cited as prior art

According to 35 U.S.C. 103(a), a patent may not be obtained "if the differences between the subject matter sought to be patented and *the prior art* are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art to which said subject matter pertains." It is clear that the phrase "prior art" as used in section 103(a) refers to those activities identified in 35 U.S.C. 102 that prevent one from obtaining a patent.

As pointed out in the reply to the previous Office action the Funakawa publication is not properly cited as prior art against the pending application. A fuller discussion of some of the sections of the Patent Act relating to prior art is set forth below.

(1) The Funakawa publication is not prior art under 35 U.S.C. 102(b)

Section 102(b) of the Patent Act reads as follows:

A person shall be entitled to a patent unless –

* * *

(b) the invention was patented or described in a printed publication in this or a foreign country . . . , more than one year prior to the date of the application for patent in the United States.

The Funakawa publication date (November 1, 2001) is less than one year before the U.S. filing date of the pending application (December 7, 2001) and, therefore, is not prior art under section 102(b).

(2) The Funakawa publication is not prior art under 35 U.S.C. 102(a)

Section 102(a) of the Patent Act reads as follows:

A person shall be entitled to a patent unless –

* * *

(a) the invention was . . . described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

The effective date of the Funakawa publication for prior art purposes under section 102(a) is the publication date (November 1, 2001), *not the U.S. or Japanese filing dates*.

Furthermore, the relevant date of the pending application under section 102(a) is the date of invention, which in this case is at least as early as the Japanese priority date (December 21, 2000). A certified copy of the priority document previously was filed. For the Examiner's convenience, an English translation of the priority document is enclosed. The pending application is entitled to the foreign filing date, which is before the publication date of the Funakawa publication. Therefore, the Funakawa publication is not prior art under sections 102(a).

(2) The Funakawa publication is not prior art under 35 U.S.C. 102(e)

Section 102(e)(1) of the Patent Act reads as follows:

A person shall be entitled to a patent unless –

* * *

(e) the invention was described in –

(1) an application for patent, published under section 122(b), by another
filed in the United States before the invention by the applicant for patent,

...

The effective date of the Funakawa publication for prior art purposes under section 102(e)(1) is the U.S. filing date (April 27, 2001), *not the Japanese filing date*. See, e.g., *Manual of Patent Examining Procedure (MPEP)*, §706.02(f)(1), Example 3 at page 700-30 (Feb. 2003).

Furthermore, the relevant date of the pending application under section 102(e)(1) is the date of invention, which in this case is at least as early as the Japanese priority date (December 21, 2000). The pending application is entitled to the foreign filing date, which is before the U.S. filing date of the Funakawa published application. Therefore, the Funakawa publication is not prior art under sections 102(e)(1).

None of the other sections of 35 U.S.C. 102 appears to be more relevant than those discussed above. The Funakawa publication, therefore, is not prior art with respect to the pending application, and the rejections should be withdrawn.

The Asami patent is not properly cited as prior art

The inventor named on the Asami patent is the same as the inventor named in the pending application. Therefore, sections 102(a) and 102(e)(2) of the Patent Act, which refer to activities *by others* before the applicant's date of invention, are inapplicable.

Furthermore, the issue date of the Asami patent (September 25, 2001) is less than one year before the filing date of the pending application (December 7, 2001). Therefore, that patent is not prior art under 35 U.S.C. 102(b) with respect to the pending claims.

Applicant's attorney notes that there may be a Japanese patent publication that corresponds to the cited Asami patent and that has a publication date more than one year before the U.S. filing date of the pending application. Applicant's attorney has not yet been able to determine whether there is such a publication. If it would be helpful, the Examiner is respectfully requested to contact the undersigned attorney to request that further inquiries be made. In any event, the U.S. Asami patent is not properly cited as prior art. Furthermore, even if there were such a corresponding prior art publication, the pending claims should be patentable over the cited references because, as already discussed, the Funakawa publication is not prior art.

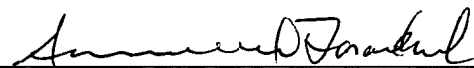
Conclusion

In view of the foregoing remarks, the Examiner is respectfully requested to reconsider and withdraw the rejections of the claims.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: 12/12/03



Samuel Borodach
Reg. No. 38,388

Fish & Richardson P.C.
45 Rockefeller Plaza, Suite 2800
New York, New York 10111
Telephone: (212) 765-5070
Facsimile: (212) 258-2291